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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/448,005	11/23/1999	DAVID L. SALGADO	690-008858-U	4554

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EXAMINER

SHERRILL, JASON L

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 03/24/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/448,005

Applicant(s)

SALGADO ET AL.

Examiner

Jason L Sherrill

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

Response to Arguments

1. In view of the appeal brief filed on 12/11/03, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3, 4, 7, 9-12, and 16-19 rejected under 35 U.S.C. 102(b) as being anticipated by Ogura (U.S. Patent No. 4,876,609).

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For claims 16 and 18, Ogura discloses an image transfer device (Fig. 1) for transferring an image disposed on a medium, the image transfer device comprising: a controller (23, Fig. 3) programmed to operate the image transfer device for performing of user selectable image transfer operations (col. 7, lines 12-19); a reader (200, Fig. 1) operably connected to the controller for reading the image on the medium (col. 4 lines 43-47); wherein the controller is programmed to determine if the image on the medium is larger than a predetermined size (col. 11, lines 19-27), and for forming a modified image on the medium if the image on the medium is larger than the predetermined size (col. 11, lines 23-29), in response to user selection of a predetermined image transfer operation from the number of user selectable image transfer operations (col. 11, lines 15-17).

For claims 4, 17, and 19, Ogura discloses the modified image is reduced to be smaller than the predetermined size (Table 2; col. 11, lines 59-63).

For claim 7, Ogura discloses a method wherein forming the modified image comprises sending an electronic embodiment of the image on the medium from the reader to the controller, and modifying the electronic embodiment to form the modified image, wherein the modified image is at least one of a cropped image or a reduced image (col. 12, lines 53-59).

Claims 1, 3, and 9-12 are the method claim corresponding to apparatus claims 16-19 above. Claims 1 and 9-12 are rejected for the same rationales set forth for claims 16-19.

Claim Rejections - 35 USC § 103

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4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ogura ('609').

For claim 6, Ogura teaches the performing the magnification of an image according to a magnification ratio (col. 11, lines 25-29). It would have been obvious to one of ordinary skill in the art to consider the magnification ratio used by Ogura to be Isotropic reduction because the ratio is applied to all dimensions of the image.

6. Claims 2, 5, 14, 20, and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogura ('609') as applied to claims 1, 9, and 16 above, and further in view of Kimbell et al (U.S. Patent No. 6,456,732).

For claims 2, 14, and 22, Ogura fails to teach a method comprising the step of rotating with the controller the modified image wherein when the modified image is transferred onto a different medium the modified image on the different medium is rotated in comparison to an orientation of the image on the medium.

Kimbell discloses an image transfer device and method capable of image orientation control comprising the step of rotating with the controller the modified image wherein when the modified image is transferred onto a different medium the modified image on the different medium is rotated in comparison to an orientation of the image on the medium (col. 3, lines 18-

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22). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the image forming method and apparatus of Ogura with the ability to orientate images as taught in Kimbell so that the modified image is rotated in comparison to the original image because both teach image forming methods and apparatuses that modify an image before outputting the image on a medium. The improvement on Ogura by Kimbell would allow for images to be orientated for the best presentation on the medium for which the image is to be displayed.

For claims 5 and 20, Ogura teaches programming for performing the magnification of an image according to a magnification ratio (col. 11, lines 25-29). It would have been obvious to one of ordinary skill in the art to consider the magnification ratio used by Ogura to be Isotropic reduction because the ratio is applied to all dimensions of the image.

Ogura fails to disclose cropping borders of the image.

Kimbell discloses cropping the borders of the image (col. 2, lines 47-56). The improvement on Ogura by Kimbell would allow for images to be orientated for the best presentation on the medium for which the image is to be displayed.

7. Claims 8, 15, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ogura ('609') as applied to claims 1, 9, and 16 above, and further in view of Salgado (U.S. Patent No. 5,946,527).

For claims 8, 15, and 21, Ogura fails to teach an image transfer device and method comprising the step of displaying a warning message with the controller on a display of the

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image transfer device, the controller displaying the warning message on the display in response to registering that the image on the medium is larger than the predetermined size.

Salgado discloses an image transfer device and method comprising the means and steps of displaying a warning message with the controller (100, Fig. 1) on a display (22, Fig. 1) of the image transfer device (10, Fig. 1), the controller displaying the warning message on the display in response to registering that the image on the medium is larger than the predetermined size (col. 6, line 52 – col. 7, line 20; col. 8, lines 11-37). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the image forming apparatus of Ogura with the ability of displaying a warning on the display as taught in Salgado because both Ogura and Salgado teach image reproduction methods and apparatuses with reduction and enlargement functions for image editing. The improvement of Ogura by Salgado would allow for a user to be notified when an image is larger than a medium of predetermined size permitting prompt action to be taken.

8. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ogura ('609'), and further in view of Sugihara et al. (U.S. Patent No. 5,991,569).

For claim 23, Ogura discloses an image transfer device (Fig. 1) for transferring an image disposed on a medium, the image transfer device comprising: a controller (23, Fig. 3) programmed to operate the image transfer device for performing of user selectable image transfer operations (col. 7, lines 12-19); a reader (200, Fig. 1) operably connected to the controller for reading the image on the medium (col. 4 lines 43-47); wherein the controller is

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programmed to determine if the image on the medium is larger than a predetermined size (col. 11, lines 19-27), in response to user selection of a predetermined image transfer operation.

Ogura fails to disclose making available for user selection the feature of cropping the image.

Sugihara discloses an image forming apparatus wherein a user may crop an image after a preview scan has been performed (col. 15, lines 19-26). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the image forming apparatus of Ogura with the ability of Sugihara to crop an image after scanning because both Ogura and Sugihara disclose image processing apparatuses capable of reducing an image to a desired ratio. The improvement on Ogura by Sugihara would allow for a user to specify image characteristics after scanning.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Sobue (U.S. Patent No. 5,610,728) discloses an image recording apparatus for recording different size images onto different sized recording sheets.


10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason L Sherrill whose telephone number is 703-306-4053. The examiner can normally be reached on M-F 7:30-4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on 703-305-4712. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JLS


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